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Atty. Dkt. No. 156.0001
Appl. No. 09/310,965

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant	:	STAN SCHALL, JR.	
Serial No.	:	09/310,965	Examiner: Fenn C. MATHEW
Filed	:	May 13, 1999	Group Art Unit: 3764
For	:	EXERCISE APPARATUS	

APPELLANT'S SUBSTITUTE BRIEF ON APPEAL

MS Appeal Brief - Patents
Commissioner of Patents
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APPELLANT'S BRIEF UNDER 37 C.F.R. 1.192

A Notice of Appeal from the final rejection of claims 1, 4-8, 10, 12-15, 17-18, and 20-28 for the above-captioned U.S. patent application was filed on July 21, 2003 along with the required filing fee. Appellant filed a Brief of Appeal under 37 C.F.R. §1.192 (*in triplicate*) together with the required brief filing fee of $160.00 under 37 C.F.R. § 1.17(c) on September 15, 2003.

The Examiner issued a Final Office Action dated November 14, 2002. Appellant filed the Notice of Appeal on March 14, 2003 with a one month extension of time. Appellant filed a four month extension of time on September 12, 2003 (extending the deadline for filing this brief until today, since September 14, 2003 was a Sunday). Appellants hereby file this Substitute Brief of Appeal (*in triplicate*) in response to the Examiner's rejections and the December 16, 2003 notice of defective brief along with the concurrently filed extension of time for one month.

1. Real Party in Interest (37 C.F.R. § 1.192(c)(1))

The real party is the named Appellant.

2. Related Appeals and Interferences (37 C.F.R. § 1.192(c)(2))

There are no appeals or interferences related to the above-captioned application which will directly affect or be directly affected by or have a bearing on the Board's decision in the present appeal.

3. Status of the Claims (37 C.F.R. § 1.192(c)(3))

This application currently has claims 1-22 pending. No claims have been cancelled. Claims 5, 11, 12, and 17-20 have been withdrawn, and thus are not reproduced in the attached Appendix I. Claims 4, 10, 13, and 14 have been allowed. Claims 1-3, 6-9, 15, 16, 21, and 22 are currently rejected.

4. Status of Amendments (37 C.F.R. § 1.192(c)(4))

There have been four amendments to this point in the prosecution. The first Amendment was filed on July 9, 2001. The first Amendment amended claims 4, 6, 10, 13, 15 and 16 and added new claim 21. The second Amendment was filed on February 19,

2002. The second Amendment amended claim 13. The third Amendment was filed on September 16, 2002. The third Amendment amended claim 15 and added new claim 22. All of these Amendments have been entered and are of record. Each of these Amendments was to non-Final Office Actions.

The fourth Amendment was filed on September 12, 2003, and was an after final amendment that amended claims 15 and 16. The Examiner indicated during a telephone conversation that an Advisory Action would be forthcoming in response to the fourth Amendment stating the amendment would not be entered for appeal purposes. This Advisory Action has not been received and there is no PAIR entry.

Claims 1-4, 6-10, 13-19, 21, and 22 are pending in this application, with claims 5, 11, 12, and 17-20 are withdrawn from consideration.

5. Summary of the Invention (37 C.F.R. § 1.192(c)(5))

Generally, the present invention is an exercise device for use in performing push-ups. The present invention also covers a method of using the exercise device. Figures 4(a)-(j) were the elected embodiment for purposes of this application in the October 12, 2000 Response to Second Election Requirement. The rejected claims are generic to more than one described exemplary embodiment.

Claim 1 recites an exercise device including an upper platform 150, a lower housing 110, a lower housing cap 130, and a bearing element 140. Specification page 5, lines 19-22, Figures 1(a)-2(b). The upper platform includes a handle 152 extending from it as illustrated in Figure 1(b) and discussed at page 8, lines 1-15 of the specification. The handle 152 includes a short upright portion 160, a tall upright portion 162, and a gripping area 164 connecting the short upright portion 160 and the tall upright portion 162. *Id.* The gripping area 164 generally is tapered as illustrated in Figure 1(b) from the short upright portion 160 to the tall upright portion 162 such that a diameter of the gripping area 164 adjacent to the short upright portion 160 is greater than a diameter of the gripping area 164 adjacent to the tall upright portion 162. Specification page 8, lines 8-12. The gripping area 164 is joined to the short upright portion 160 with an elbow and to the tall upright portion

162 with an elbow as illustrated in Figure 1(b). The lower housing 110 engages the upper platform as discussed in an exemplary embodiment from page 5, line 26 to page 6, line 4 and illustrated in Figure 4(b). The lower housing cap 130 preferably abuts the lower housing 110 as illustrated in Figure 1(b). Preferably, the lower housing cap 130 has an opening passing through it as illustrated in Figure 4(b), for example. The bearing element 140 is adjacent to the upper platform 150 and to the lower housing cap 130 as illustrated, for example, in Figure 4(b).

Claim 21 recites a method for using a pair of the devices recited in claim 1. The first step is to place the devices about shoulder width apart as illustrated, for example, in Figure 11 (c). The next two steps recite placement of the pinkie of the user's hands near the tall upright portion on the respective device. *See* specification page 8, lines 9-15; Fig. 1(c) (showing the placement of the hand on the handle 152). The last step recites performing a push-up where at least one of the upper platforms 150 rotates with respect to its respective lower housing 100. *See* specification page 5, lines14-16.

Claim 6 recites an exercise device having an upper platform 150, a lower housing 110, a lower housing cap 130, a bearing element 140, and regulating components. *See supra*, specification page 10, lines 11-19. The regulating components as exemplified in Figure 4 include elements 160, 170a, and 180a. *See* specification page 12, lines 8-10. The lower housing 110a includes a floor with a hole passing through it as illustrated, for example, in Figure 4(b). The lower housing cap 130 rests on and is aligned with the lower housing 110 as illustrated in Figure 4(b). The bearing element 140 rests on the lower housing cap 130 and abuts the upper platform 150 as illustrated, for example, in Figure 4(b). The bearing element 140 allows the upper platform 150 to rotate relative to the lower housing 110. *See* specification page 7, lines 13-30; Figs. 1(b), 3(b), 4(b). The regulating components control rotation between the lower housing 100 and the upper platform 150. Specification page 10, lines 18-19. The regulating components includes an adjustment mechanism 160 that is accessible from the bottom of the device as illustrated, for example,

in Figures 4(b), 5(b), 6(b), 7(b), 7(c), 8(h), and 9(b). *See also*, specification page 26, lines 5-8 (discussing an alternative embodiment for the adjustment mechanism).

Claim 15 recites an exercise device having an upper platform 150, a lower housing 110, a lower housing cap 130, a bearing element 140, and regulating components. *See supra*, specification page 10, lines 11-19. The regulating components as exemplified in Figure 4 include elements 160, 170a, and 180a. *See* specification page 12, lines 8-10. The upper platform 150 includes a bottom surface (*see, e.g.*, the bottom of the horizontal portion of 150 in Fig. 1(b)), an upper surface opposed to the bottom surface (*see, e.g.*, the top of the horizontal portion of 150 in Fig. 1(b)), and a fist pad 152' attached to the upper surface. *See* Figs. 2(b), 3(c); specification page 8, lines 28-29. The lower housing 110a is connected to the upper housing 150 as discussed in an exemplary embodiment from page 5, line 26 to page 6, line 4 and illustrated in Figure 4(b). The lower housing cap 130 rests on and is aligned with the lower housing 110 as illustrated in Figure 4(b). The bearing element 140 rests on the lower housing cap 130 and abuts the upper platform 150 as illustrated, for example, in Figure 4(b). The bearing element 140 allows the upper platform 150 to rotate relative to the lower housing 110. *See* specification page 7, lines 13-30; Figs. 1(b), 3(b), 4(b). The regulating components control rotation between the lower housing 100 and the upper platform 150. Specification page 10, lines 18-19.

Claim 16 recites an exercise device having an upper platform 150, a lower housing 110, a lower housing cap 130, a bearing element 140, a stopper 156', and regulating components. *See, e.g., supra*, specification page 9, lines 24-27 and page 10, lines 11-19. The regulating components as exemplified in Figure 4 include elements 160, 170a, and 180a. *See* specification page 12, lines 8-10. The lower housing 110a is connected to the upper housing 150 as discussed in an exemplary embodiment from page 5, line 26 to page 6, line 4 and illustrated in Figure 4(b). The lower housing cap 130 rests on and is aligned with the lower housing 110 as illustrated in Figure 4(b). The bearing element 140 rests on the lower housing cap 130 and abuts the upper platform 150 as illustrated, for example, in Figure 4(b). The bearing element 140 allows the upper platform 150 to rotate relative to

the lower housing 110. *See* specification page 7, lines 13-30; Figs. 1(b), 3(b), 4(b). The regulating components control rotation between the lower housing 100 and the upper platform 150. Specification page 10, lines 18-19. The upper platform 150' includes a wall 151' extending downwardly from a peripheral edge and the wall 151' has an opening passing through it as illustrated, for example, in Figure 3(b). The lower housing 100 includes an opening passing through it such that when the opening of the lower housing 100 and the opening of the upper platform 150 are aligned, the stopper is capable of engaging the openings. Specification page 9, lines 24-26; Fig. 3(b). Claim 22 depends from claim 16 and further recites that "at least a portion of said regulating components are within said lower housing." *See, e.g.*, Figs. 4(b), 5(b), 6(b), 7(b), 7(c), 8(h), and 9(b)

6. Issues (37 C.F.R. § 1.192(c)(6))

(1) Whether claim 2 is definite under 35 U.S.C. §112, second paragraph.

(2) Whether claims 6, 7, and 9 are patentable under 35 U.S.C. §102(b) over U.S. Patent No. 1,533,500 to Hovda.

(3) Whether claim 16 is patentable under 35 U.S.C. §103(a) over Thomas, Jr.

(4) Whether claims 1-3, 21, and 22 are patentable under 35 U.S.C. §103(a) over Thomas, Jr., U.S. Patent No. 5,226,868 to Montgomery, and U.S. Patent Des. 141,456 to Karstadt.

(5) Whether Thomas, Jr., Montgomery, and Karstadt are properly combinable under 35 U.S.C. §103(a).

(6) Whether claims 6, 7, and 9 are patentable under 35 U.S.C. §103(a) over Hovda.

(7) Whether claim 8 is patentable under 35 U.S.C. §103(a) over Hovda in view of U.S. Patent No. 2,256,001 to Titus.

(8) Whether Hovda and Titus are properly combinable under 35 U.S.C. §103(a).

7. Grouping of the Claims (37 C.F.R. § 1.192(c)(7))

The claims should be treated as six separate groups:

Group I - Claim 2;

Group II - Claims 1-3, 21, and 22 do not stand or fall together;

Group III - Claims 6, 7, and 9 stand or fall together;

Group III - Claim 8;

Group IV - Claim 16.

Applicant submits that the Group II claims do not stand or fall together for the reasons more fully developed and expressed in the Argument section below. These claims are divided into three sets: a) 1-3, b) 21, and c) 22 as these claim sets are separately patentable from each other.

8. Argument (37 C.F.R. § 1.192(c)(8))

i. 35 U.S.C. §112 rejection, second paragraph

The Final Office Action has rejected claim 2 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant considers as the invention. More particularly, the Final Office Action rejects claim 2 for the use of the phrase "horizontal plane." Appellant respectfully submits that this rejection is improper.

This rejection was originally made in the first Office Action, and was addressed in the first Amendment resulting in the rejection being withdrawn in the second Office Action. The rejection then reappeared in the third Office Action and was repeated in the fourth Final Office Action.

Claim 2 recites "said gripping area includes a bottom angle at fourteen degrees with the horizontal plane." Appellant submits that the phase "the horizontal plane" is inherent and does not require an antecedent recitation, because the gripping area is angled based on the recitation of "a tall upright portion" and "a short upright portion" in claim 1. *See* MPEP 2173.05(e). Thus, "the horizontal plane" is inherent as existing due to the gripping area being angled and one way to describe such an angle is relative to "the horizontal plane" as was done in claim 2. *See, e.g.*, specification page 8, lines 6-8, page 27, lines 15-16. Additionally, when an individual reads the claim they would understand that "horizontal plane" is being used as a reference plane to define the structure recited in claim 2.

Appellant respectfully submits that this indefiniteness rejection is improper and should be overturned.

ii. 35 U.S.C. § 102 rejection

Claims 6, 7 and 9 have been rejected under 35 U.S.C. §102(b) as allegedly anticipated by or, in the alternative, under 35 U.S.C. §103(a)1 as allegedly obvious over Hovda (U.S. Pat. No. 1,533,500). Appellant respectfully submits that this rejection is improper.

The nuts 21, screw bolt (only partially threaded) 19, and head (which is the head of screw bolt 19) 20 of Hovda should not be considered to be regulating components as recited in claim 6. *See* Hovda, page 1, lines 77-83. These three elements in Hovda form the central pivotal members. The device disclosed in Hovda is for teaching the concepts of the conservation of angular momentum and/or energy of rotation. Hovda, page 1, lines 9-13 and page 1, line 101 to page 2, line 27. The entire purpose of the device is to have the two discs 1 and 2 be able to freely rotate relative to each other without having the amount of rotation restricted. Therefore, elements 19, 20, and 21 are disclosed for the purposes of holding the two discs together. In fact as illustrated in Figure 1 (reproduced below) of Hovda, bolt head 20 and nuts 21 are like two pieces of bread in a sandwich where the filler is disc 1, bearing plate 8 with circular groove 9, antifriction balls 22, bearing plate 12 with circular groove 13 and circular groove 18, antifriction balls 22 in the circular groove 18, and a lower portion. The lower portion includes lower disc (or plate) 2 that is shaped like a donut connected directly to bearing plate 12 and in the center of the donut is plate 16 with circular groove 17 that matches circular groove 18. The screw bolt 19 passes through respective holes in disc 1 and bearing plates 8 and 12. The screw bolt 19 is threaded to plate 16 and "[n]uts 21 are provided for locking the plate 16 in its adjusted position." Hovda, page 1, lines 77-83. The screw bolt 19 and nuts 21 are not meant to be adjusted and in fact can not be adjusted as the screw bolt 19 only is partially threaded as shown in Figure 1 (reproduced below).

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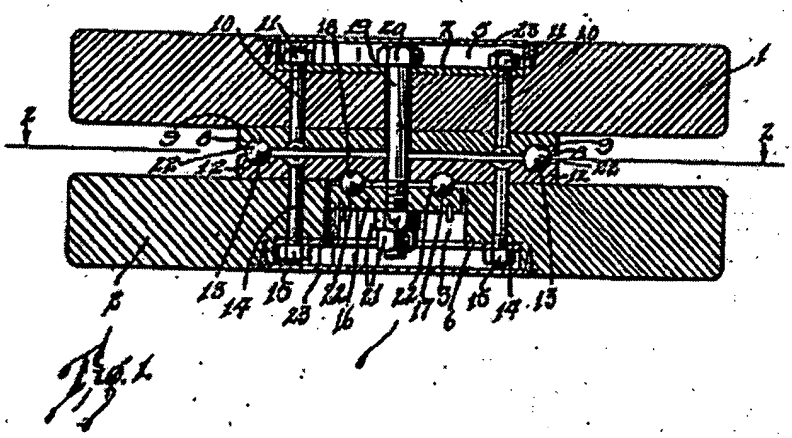
1 The 35 U.S.C. §103(a) rejections addressed later in this Appeal Brief.



This interpretation is confirmed by claim 1, which recites "a central pivotal member for securing said discs together." Hovda, page 2, lines 36-37. *See also* Hovda claim 2. Therefore, Hovda does not disclose regulating components including an adjustment mechanism as recited in claim 6. Appellant respectfully submits that claim 6 is not anticipated by Hovda and claims 7 and 9 that depend from claim 6 are not anticipated by Hovda, and that this rejection should be withdrawn and overturned.

iii. 35 U.S.C. §103 rejection

a. 35 U.S.C. §103(a) based on Thomas, Jr.

Claim 16 has been rejected under 35 U.S.C. §103(a) as allegedly anticipated by Thomas, Jr. Appellant respectfully submits that this rejection is improper.

The Appellant has the right to be his own lexicographer and define terms in the specification in particular ways for use in the claims. *See, e.g., Johnson Worldwide Assocs., Inc. v. Zebco Corp.*, 175 F.3d 985, 990 (Fed. Cir. 1999); *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994). When the Appellant defines a term, that definition is to be used in analyzing the claims. *See Johnson Worldwide Assocs., Inc.*, at 990; *In re Paulsen*, at 1480.

Claim 16 recites a stopper that engages the lower housing and the upper housing such that the two housings will not rotate relative to each other. The stopper is described and defined, for example, in the last paragraph on page 9 of the specification and illustrated, for example, as element 156' in Figures 3(a)-(c). The specification defines the

stopper as any component that engages an opening passing through the lower housing and an opening passing through a wall extending down from the upper platform. *Id.*; claim 16.

The first bearing surface 110 and second annular lip 114 with a second bearing surface 116 of Thomas are incapable of providing resistance and stopping power to preventing the rotating platform 24 from rotating relative to the base 22. *See* col. 7, lines 10-31, Fig. 9. In fact, the very names of these elements indicate these elements are present in Thomas for allowing the rotating platform 24 to rotate relative to the base 22, which is contrary to the recited stopper in claim 16. In addition, the opening that is referred to in paragraph 7 of the Office Action is not an opening that if plugged would prevent rotation of the rotating platform 24 relative to the base 22, since the item that would be inserted into that opening, which is parallel to the rotating platform 24, would be on the central axis of rotation of the rotating platform 24. *See* Thomas, Fig. 9 (reproduced below).

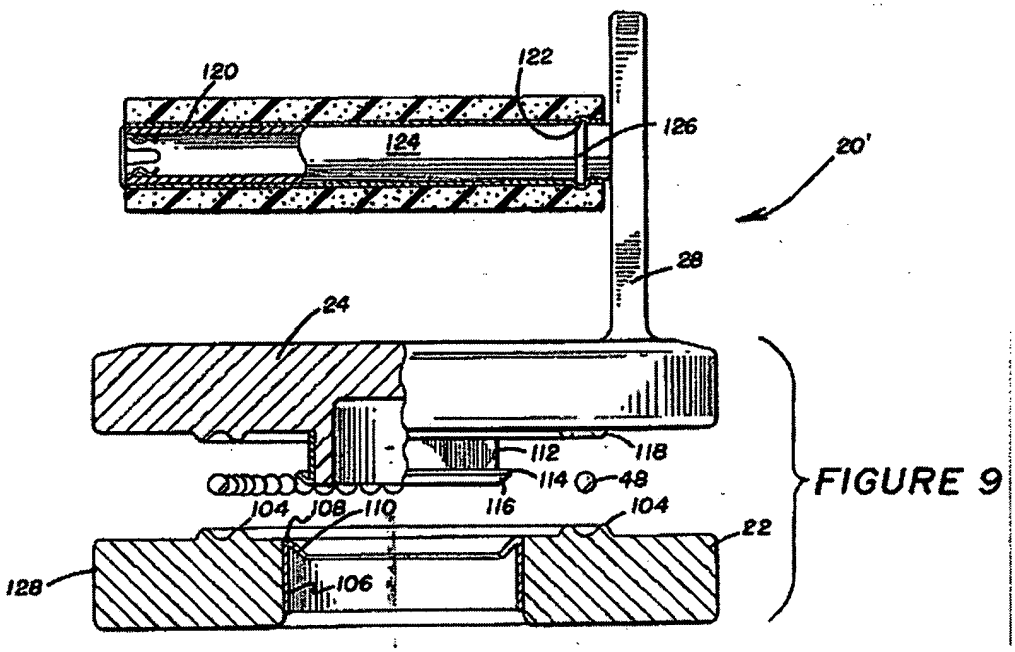


FIGURE 9

Thomas also fails to teach the openings recited in claim 16 that are present in the wall extending down from the upper platform and the lower housing.

Additionally, the proposed modification of Thomas to include a "stopper" would destroy the purpose of the disclosed device. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (finding no suggestion to modify a prior art device where the modification would render the device inoperable for its intended purpose). Thomas makes it clear that a purpose of the invention is to allow for the rotating platform 24 to rotate relative to the base 22 in view of the problem that during a push-up it is natural for the wrist to want to go through a twisting motion. *See* Thomas, col. 1, lines 18-60. When Thomas does add resistance to his device, rotation still occurs between the rotating platform 24 and the base 22 only the level of resistance increases. Thomas, col. 6, lines 28-45.

Appellant respectfully requests that this rejection be overturned and withdrawn.

b. 35 U.S.C. §103(a) based on Thomas, Montgomery, and Karstadt combination

Claims 1-3, 21 and 22 have been rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Thomas in view of Montgomery (U.S. Pat. No. 5,226,868) and Karstadt (U.S. Pat. No. D141,456). Appellant respectfully submits that this rejection is improper. Appellant submits that these claims are separately patentable.

Appellant respectfully submits that the combination is improper and that this argument applies to the three claim sets. "There is no suggestion to combine . . . if a reference teaches away from its combination with another source . . . . 'A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the Appellant . . . [or] if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the Appellant.'" *Tec Air, Inc. v. Denso Mfg. Mich. Inc.*, 192 F.3d 1353, 1360, 52 USPQ2d 1294 (Fed. Cir. 1999) (*citing In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994). If a first reference (Thomas) does teach away from a second reference (Montgomery), then that fact alone can defeat an obviousness

rejection based on a combination using these two references. *See Winner Int'l Royalty Corp. v. Wang*, 202 F.3d 1340, 1350, 53 USPQ2d 1580 (Fed. Cir. 2000).

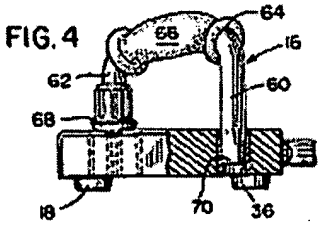
Thomas teaches that an existing problem with the push-up exercise, which as part of the exercise it is natural for the wrists to twist simultaneously with the movement of the arms during both the extension and retraction. Thomas, col. 1, lines 29-31. However, the "traditional push-up exercise does not allow this twisting motion and consequently the strain of resisting the natural motion must also be absorbed by the wrist." Thomas, col. 1, lines 31-34. Thomas goes on to state that "a fist push-up does nothing to eliminate the stress created by resistance to the natural twisting motion." Thomas, col. 1, lines 45-47. At the end of the background section, Thomas confirms the problem being addressed by stating none of the known prior devices "assist in alleviating the strain on the delicate wrist bones and muscles occurring during the exercising event of a push-up." Thomas, col. 2, lines 44-46. Thomas also states an advantage of the device as "allowing the user to follow the natural **rotational** movement of his body during the push-up exercise." Thomas, col. 3, lines 32-35 (emphasis added). Even when an external resistance is applied to the device (or a pair of devices), the rotating platform 24 is still able to rotate relative to the base 22. *See* Thomas, col. 4, lines 13-26 and Fig. 2; col. 6, lines 28-45 and Fig. 7.

On the other hand, Montgomery lists that one of the objects of his device is to provide

> a power push-up device having a push-up board onto which are pivotally mounted two C-shaped handles [16] having one end fitable into the board and the opposite end having an anti-skid cushion [68] **to lock the position of the handles during push-up exercises**.

Col. 2, lines 32-37 (emphasis added). *See* Montgomery, Fig. 4 (reproduced below).

FIG. 4



The objective to lock the handles in place is repeated using the same language in the next three stated objectives. *See* col. 2, lines 42, 50, 60. One of ordinary skill in the art when reviewing Montgomery would be taught that the device has handles that are stationary once placed on the board and remain stationary during the push-up exercise, and would not consider taking the disclosed handle and combining it with a handle from Thomas, because Thomas requires that its handle is rotatable. Therefore, under *Winner Int'l Royalty Corp.* this is not a proper combination.

Appellant respectfully submits that the reliance upon Karstadt is improper because Karstadt is nonanalogous art, because the Final Office Action has failed to provide a rationale as to why the relevant standard is met. The standard for determining whether a piece of art is analogous is 1) whether the art is within the field of the inventor's endeavor, and 2) if the art is not, then to determine whether the art is reasonably pertinent to the particular problem which the invention solves. *In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313 (Fed. Cir. 1986). Karstadt is a design patent for an iron, which is clearly outside the field of exercise devices and more particularly, push-up devices. The second prong is also not satisfied because an iron design is not reasonably pertinent to the problem solved by the invention as described in, for example, the background of the invention of this patent application. Additionally, common sense would not reasonably lead a person of ordinary skill into searching through the iron art to find a solution to a problem arising in connection to exercise devices. *See In re Oetiker*, 977 F.2d 1443, 1447, 24 USPQ.2d 1443 (Fed. Cir. 1992). Therefore, claims 1-3 and 21 are patentable because Karstadt is nonanalogous art and is not within the knowledge of one of ordinary skill in the art. Furthermore, Karstadt offers no motivation, teaching or suggestion for making this combination.

Therefore, Appellant submits that these claims are patentable as the relied upon combination is improper. The remainder of the discussion for this rejection will discuss the three sets of claims individually and what aspects provide for separate patentability where appropriate.

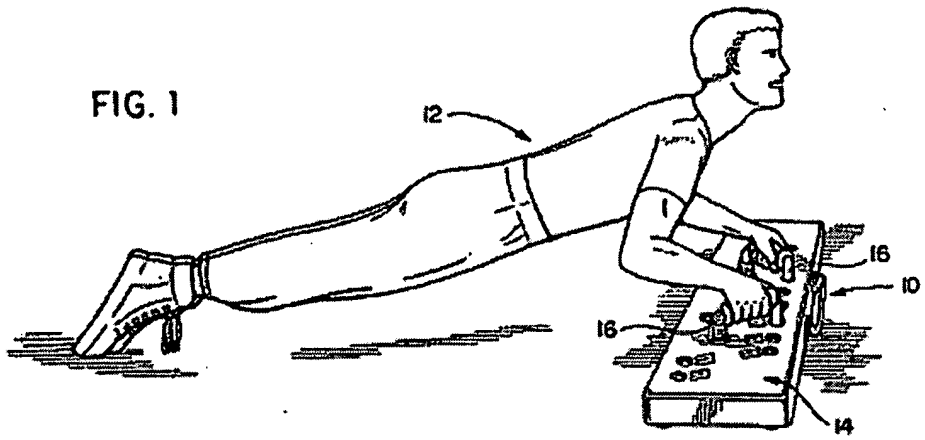
Claims 1-3

Claims 1-3 are patentable over this combination, because the combination is improperly constructed based upon hindsight. The Federal Circuit has continuously stressed against the use of hindsight in rejecting claims particularly when the technology is straightforward. More particularly, an office action cannot state a rejection based on "hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). The Office Action has described a combination that takes the handle shape aspects from Montgomery and Karstadt to combine them together to take the place of the handle taught by Thomas using the recitation of claim 1 as the roadmap, while providing relatively conclusory statements to provide motivation, which is improper. *See id.*; *In re Lee*, 277 F.3d 1338, 61 USPQ.2d 1430 (Fed. Cir. 2002). Appellant respectfully requests that the rejection of Claims 1-3 be withdrawn and overturned.

Claim 21

Claim 21 recites a method for using the device recited in claim 1 including a specific placement of the pinkie on each hand on a respective device, i.e., adjacent the tall upright portion, which is not an apparent placement given the device. Based on the patents relied upon in the Final Office Action, it is quite clear that Montgomery teaches the placement of the pinkie by the short upright as illustrated in Figure 1 (reproduced below), which provides the description for how the user would use the conglomeration proposed in the Final Office Action. *See also* Montgomery, Fig. 4 (reproduced above) (shows a side view of the handle in the board with the short upright portion being designated 62).

FIG. 1



Additionally, someone who is ironing typically places their pinkie adjacent to the rear of the iron, which would be adjacent to the upright having a wider gripping area in Figure 2 of Karstadt. After selective use of the patents (which is contrary to established precedent, *see In re Fine*, 837 F.2d 1071, 5 USPQ.2d 1596 (Fed. Cir. 1988)), a combination is proposed in the Final Office Action that places the wider gripping area adjacent to the short upright, which provides a second statement out of the three patents for placement of the user's pinkie. Thomas is silent as to location, because its handle is completely horizontal and parallel to the floor with one free end, which allows the handle to rotate about its axis. The placement of the user's pinkie in claim 21 is not to increase the difficulty but to address ergonomical concerns that are not addressed or discussed in any of the art relied upon in the Final Office Action. *See* specification, page 8, lines 9-15. *See also* specification, page 2, lines 27-28, page 3, line 7. An exerciser upon seeing the claimed invention would instinctively grab the handle in the manner described by Montgomery, and thus it is counterintuitive to grab the handle as recited in the method of claim 21.

Claim 22

Claim 22 is patentable over this combination based upon the recitation of "at least a portion of said regulating components are within said lower housing." This recitation and some of the recitation from claim 16 are not present in claims 1-3 and/or 21.

This probably is because none of the patents discusses placing any type of element inside of the respective devices for regulating the rotation between the upper platform and

the lower housing. The proposed combination does not teach or suggest that the belt taught in Thomas be at least partially located within a lower housing. Thomas only discloses the placement of a belt 98 around the outside of the device, and thus the belt 98 is external to the base 22. Montgomery is silent on the use of allowing any level of regulation of rotation of the handle as the handle is meant to remain in place (as discussed above). Karstadt also is silent as the handle is not meant to rotate separate from the ironing portion. Thus, when the combination is made there is no teaching of the recited regulating components being present within the lower housing. Additionally as discussed above, claim 16 is submitted as being patentable over Thomas, and thus claim 22 which depends from claim 16 should be determined to be patentable. The combination also fails to teach or suggest a stopper and the pair of openings recited in claim 16. Appellant respectfully requests that this rejection be withdrawn and overturned with respect to the claim 22.

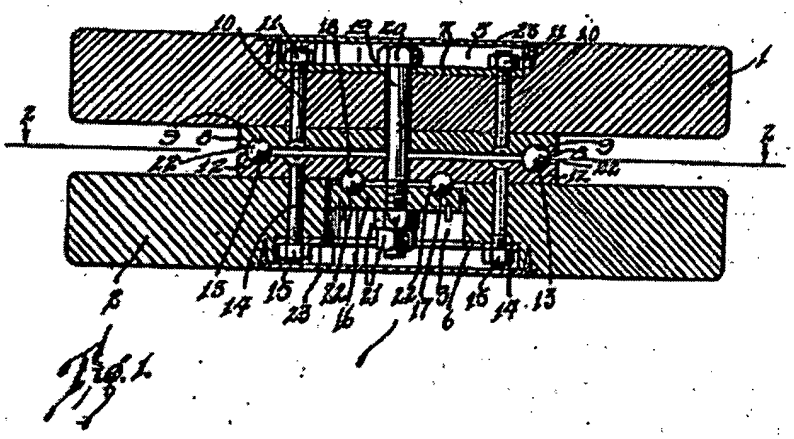
Therefore, Appellant respectfully submits that this rejection should be overturned and withdrawn as to each of claims 1-3, 21, and 22.

c. 35 U.S.C. §103(a) based on Hovda

Claims 6, 7 and 9 have been rejected 35 U.S.C. §103(a) as allegedly obvious over Hovda (U.S. Pat. No. 1,533,500). Appellant respectfully submits that this rejection is improper.

The nuts 21, screw bolt (only partially threaded) 19, and head (which is the head of screw bolt 19) 20 of Hovda should not be considered to be regulating components as recited in claim 6. *See* Hovda, page 1, lines 77-83. These three elements in Hovda form the central pivotal members. The device disclosed in Hovda is for teaching the concepts of the conservation of angular momentum and/or energy of rotation. Hovda, page 1, lines 9-13 and page 1, line 101 to page 2, line 27. The entire purpose of the device is to have the two discs 1 and 2 be able to freely rotate relative to each other without having the amount of rotation restricted. Therefore, elements 19, 20, and 21 are disclosed for the purposes of holding the two discs together. In fact as illustrated in Figure 1 (reproduced below) of

Hovda, bolt head 20 and nuts 21 are like two pieces of bread in a sandwich where the filler is disc 1, bearing plate 8 with circular groove 9, antifriction balls 22, bearing plate 12 with circular groove 13 and circular groove 18, antifriction balls 22 in the circular groove 18, and a lower portion. The lower portion includes lower disc (or plate) 2 that is shaped like a donut connected directly to bearing plate 12 and in the center of the donut is plate 16 with circular groove 17 that matches circular groove 18. The screw bolt 19 passes through respective holes in disc 1 and bearing plates 8 and 12. The screw bolt 19 is threaded to plate 16 and "[n]uts 21 are provided for locking the plate 16 in its adjusted position." Hovda, page 1, lines 77-83. The screw bolt 19 and nuts 21 are not meant to be adjusted and in fact can not be adjusted as the screw bolt 19 only is partially threaded as shown in Figure 1 (reproduced below).



This interpretation is confirmed by claim 1, which recites "a central pivotal member for securing said discs together." Hovda, page 2, lines 36-37. *See also* Hovda claim 2. Therefore, Hovda does not disclose regulating components including an adjustment mechanism as recited in claim 6.

Additionally, Hovda does not teach or suggest the invention recited in claim 6, because one of ordinary skill in the art reading the Hovda patent would determine that it teaches away from a device having "regulating components that control rotation between said lower housing and said upper platform" as recited in claim 6. Hovda, page 1, lines 9-21. *See Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 448, 230

USPQ 416 (Fed. Cir. 1986)(a reference should be considered as a whole, and portions arguing against or teaching away from the claimed invention must be considered (*citing W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1550, 220 USPQ 303, 311 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984))); *In re Gordon*. Therefore, Hovda is unable to teach or suggest claim 6. Claims 7 and 9 are likewise patentable over Hovda in view of their dependency from claim 6.

Additionally, the rejection of claim 7, which recites that the regulating components include friction material, based upon threads being present on screw bolt 19 of Hovda is insufficient. Hovda does not disclose any friction material or other resistance causing component, which is contrary to the entire purpose of the Hovda device being an educational tool to show the concepts of angular momentum, which requires a free spinning device. This purpose also prevents the modification of Hovda to include friction material, because the device would become inoperable for its purpose. *See Bausch & Lomb, Inc.*, at 448; *In re Gordon*. It is submitted that screw bolt 19 of Hovda is not identical to the friction material recited in claim 7, nor can it teach or suggest the recited friction material in claim 7.

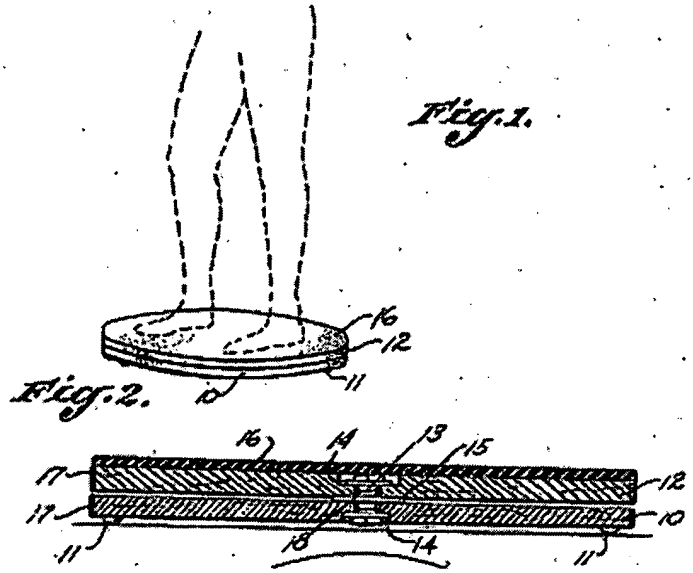
Therefore, Appellant respectfully submits that reconsideration and withdrawal of the present rejection is proper and such action is respectfully requested.

d. 35 U.S.C. §103(a) based on Hovda and Titus combination

Claim 8 has been rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Hovda in view of Titus (U.S. Pat. No. 2,256,001). Appellant respectfully submits that this rejection is improper.

Claim 8 is submitted as being patentable over this combination in view of its dependency from claim 6, which is submitted above as being patentable. Additionally, Hovda teaches away from this combination since a stated objective is "to provide a device consisting of a revolvable disc mounted thereon for supporting the demonstrator, and so constructed that the base and the revolving disc may be used interchangeably, that is to say, the base may be used as a supporting disc, or vice versa." Hovda, page 1, lines 26-

36. The Final Office Action fails to explain how adding a footing to lower plate 2 will still allow the Hovda device to be flipped over and have lower plate 2 available to be stood upon for a demonstration, because Hovda discloses an educational tool, not an exercise device. The device disclosed in Titus is only operable for its purposes when the rubber feet (or footings) 11 are against the floor and not when plate 10 is on top. *See* Titus, Figs. 1 and 2 (reproduced below). Therefore, Appellant respectfully submits that the combination of Hovda and Titus is improper, because the modification of Hovda with footings defeats one of the objectives of Hovda.



Therefore, Appellant respectfully submits that reconsideration and withdrawal of the present rejection is proper and such action is respectfully requested.

9. Conclusion

In view of all of the foregoing, it is respectfully submitted that the Examiner's final rejections of the claims fail to establish 1) claim 2 is indefinite under 35 U.S.C. §112, second paragraph, 2) *prima facie* anticipation of claims 6, 7, and 9 based on Thomas, 3) *prima facie* obviousness of claim 16 based on Thomas, 4) *prima facie* obviousness of claims 1-3, 21, and 22 based on Hovda, 5) *prima facie* basis to combine Thomas, Montgomery, and Karstadt in making an obviousness rejection as they are not combinable, 6) *prima facie* obviousness of claims 6, 7, and 9 based on Hovda, 7) *prima facie*

obviousness of claim 8 based on a combination of Hovda and Titus, 8) *prima facie* basis to combine Hovda and Titus. None of the references, taken alone or in combination, teach, suggest or disclose all of the limitations of the claims. Withdraw or reversal of the final rejections and allowance of all claims on appeal are respectfully requested.

Respectfully submitted,
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Appendix I

1. An exercise device comprising:

an upper platform having a handle extending therefrom, said handle having a short upright portion, a tall upright portion, and a gripping area connecting said short upright portion and said tall upright portion, said gripping area generally is tapered from said short upright portion to said tall upright portion such that a diameter of said gripping area adjacent to said short upright portion is greater than a diameter of said gripping area adjacent to said tall upright portion, said gripping area is joined to said short upright portion with an elbow, said gripping area is joined to said tall upright portion with an elbow,

a lower housing engaging said upper platform,

a lower housing cap abutting said lower housing, said lower housing cap having an opening passing therethrough, and

a bearing element adjacent to said upper platform and said lower housing cap.

2. The exercise device according to claim 1, wherein

said gripping area includes a bottom angled at fourteen degrees with the horizontal plane,

said tall upright portion is tapered out from said gripping area to said upper platform, and

said gripping area includes an arch along a top surface that extends out of a conical envelope around the tapering of said gripping area.

3. The exercise device according to claim 1, wherein

said lower housing cap having an opening passing therethrough, and

said bearing element having an opening passing therethrough.

4. The exercise device according to claim 3, wherein

said lower housing having

a bottom surface having an opening passing therethrough,

a wall extending up from said bottom surface, and

a central passageway, said central passageway extends up from the opening in said bottom surface, said central passageway includes

a threaded section, and

a locking section having a circular cross-section with at least one keyway channel radially extending from said circular cross-section;

said upper platform having

a bottom surface,

a nesting unit extending downward from said bottom surface, said nesting unit including an outer wall forming a recess, said nesting unit passes through the opening of said bearing element; and

said exercise device further including regulating components, said regulating components include

friction material in communication with the recess of said nesting unit,

an adjustment device having a screw mechanism, said screw mechanism engages said threaded section of said lower housing, and

a compression component aligned with said adjustment device, said compression component having

a lower portion with at least one guide key, said at least one guide key engages said at least one keyway channel of said lower housing, and

a upper portion, said upper portion is tapered radially inward from said lower portion to a top of said upper portion, said upper portion nests within said recess of said nesting unit to apply compression forces to said friction material, said upper portion extends through the opening in said lower housing cap and the opening in said bearing element.

5. withdrawn - not in appeal

6. An exercise device comprising:

a upper platform,

a lower housing connected to said upper platform, said lower housing includes a floor with a hole passing therethrough,

a lower housing cap resting on and aligned with said lower housing,

a bearing element resting on said lower housing cap and abutting said upper platform, said bearing element allows said upper platform to rotate relative to said lower housing, and

regulating components that control rotation between said lower housing and said upper platform, said regulating components include an adjustment mechanism; and

wherein said adjustment mechanism is accessible through the hole in said floor of said lower housing.

7. The exercise device according to claim 6, wherein said regulating components include a friction material that is variably set to provide a range of resistance levels.

8. The exercise device according to claim 6, further comprising

a footing attached to said lower housing opposite said lower housing cap.

9. The exercise device according to claim 6, wherein

said lower housing cap having an opening passing therethrough, and

said bearing element having an opening passing therethrough.

10. An exercise device comprising:

a upper platform,

a lower housing connected to said upper platform,

a lower housing cap resting on and aligned with said lower housing,

a bearing element resting on said lower housing cap and abutting said upper platform, said bearing element allows said upper platform to rotate relative to said lower housing, and

regulating components that control rotation between said lower housing and said upper platform; and

wherein said lower housing cap having an opening passing therethrough,

said bearing element having an opening passing therethrough,

said lower housing having

a bottom surface having an opening passing therethrough,

a wall extending up from said bottom surface, and

a central passageway, said central passageway extends up from the opening in said bottom surface, said central passageway includes

a threaded section, and

a locking section having a circular cross-section with at least one keyway channel radially extending from said circular cross-section;

said upper platform having

a bottom surface,

a nesting unit extending downward from said bottom surface, said nesting unit including an outer wall forming a recess, said nesting unit passes through the opening of said bearing element; and

said regulating components include

friction material in communication with the recess of said nesting unit,

an adjustment device having a screw mechanism, said screw mechanism engages said threaded section of said lower housing, and

a compression component aligned with said adjustment device, said compression component having

a lower portion with at least one guide key, said at least one guide key engages said at least one keyway channel of said lower housing, and

a upper portion, said upper portion is tapered radially inward from said lower portion to a top of said upper portion, said upper portion nests within said recess of said nesting unit to apply compression forces to said friction material, said upper portion

extends through the opening in said lower housing cap and the opening in said bearing element.

11. withdrawn - not in appeal

12. withdrawn - not in appeal

13. An exercise device comprising:

a lower housing including a lower housing cap, a cylindrical base, and a rim around a periphery of said cylindrical base, said lower housing cap rests on said cylindrical base, said lower housing cap having an opening passing therethrough,

an upper housing shrouding said cylindrical base, said upper housing includes a platform, a cylindrical extension extending down from said platform, a handle extending upward from said platform, and a rim around an inside cavity of said cylindrical extension, said rim engages said rim of said lower housing,

means for allowing rotation of said platform of said upper housing relative to said lower housing such that said lower housing remains stationary while said platform freely rotates on said lower housing, said means providing an opening passing therethrough aligned with the opening of said lower housing cap, and

means for resisting rotation in communication with said lower housing and said upper housing, said resisting rotation means are internal to said lower housing and said upper housing, said resisting rotation means passing through the opening in said lower housing cap and the opening in said rotating means.

14. The exercise device according to claim 10, wherein said upper platform further includes

an upper surface opposed to said bottom surface, and

a fist pad attached to said upper surface and extending above said upper surface.

15. An exercise device comprising:

a upper platform, said upper platform includes

a bottom surface,

an upper surface opposed to said bottom surface, and

a fist pad attached to said upper surface and extending above said upper surface,

a lower housing connected to said upper platform,

a lower housing cap resting on and aligned with said lower housing,

a bearing element resting on said lower housing cap and abutting said upper platform, said bearing element allows said upper platform to rotate relative to said lower housing, and

regulating components that control rotation between said lower housing and said upper platform.

16. An exercise device comprising:

a upper platform,

a lower housing connected to said upper platform,

a lower housing cap resting on and aligned with said lower housing,

a bearing element resting on said lower housing cap and abutting said upper platform, said bearing element allows said upper platform to rotate relative to said lower housing,

regulating components that control rotation between said lower housing and said upper platform, and

a stopper; and

wherein said upper platform includes a wall extending downwardly from a peripheral edge, said wall having an opening passing therethrough,

said lower housing includes an opening passing therethrough, when the opening of said lower housing is aligned with the opening of said upper housing, said stopper engages the opening of said lower housing and said upper housing.

17. withdrawn - not in appeal

18. withdrawn - not in appeal

19. withdrawn - not in appeal

20. withdrawn - not in appeal

21. A method for using a pair of the exercise devices recited in claim 1, said method comprising:

positioning the pair of devices about shoulder width apart on a support surface,

placing the pinkie of the user's right hand on the gripping area near the tall upright portion of one of the devices,

placing the pinkie of the user's left hand on the gripping area near the tall upright portion of the other of the devices, and

performing a push-up where at least one of the upper platforms rotates with respect to the respective lower housing.

22. The exercise device according to claim 16, wherein at least a portion of said regulating components are within said lower housing.